

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.: 10/760,129
Appellant: Peter S. Brown et al.
Filed: January 16, 2004
Title: ENDOVASCULAR GRAFT WITH PRESSOR AND ATTACHMENT
METHODS
T.C./A.U.: 3738
Examiner: Cheryl L. Miller
Confirmation No.: 7202
Docket No.: BSI-566US

REPLY BRIEF UNDER 37 C.F.R. § 41.37

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S I R :

Appellants submit this Reply Brief in response to the Examiner's Answer mailed on September 24, 2007. The arguments set forth herein address issues raised in the Examiner's Answer and supplement the arguments set forth in the Appeal Brief filed on August 21, 2007.

This Brief is presented in the format required by 37 C.F.R. § 41.37, in order to facilitate review by the Board. In compliance with 37 C.F.R. § 41.37(a)(1), this Brief is being filed within two months from the date of mailing of the Examiner's Answer.

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I. STATUS OF CLAIMS

Claims 3, 5, 6 and 9-27 are cancelled.

Claims 1, 2, 4, 7, 8 and 28-33 are pending and stand finally rejected. Claims 1, 2, 4, 7, 8 and 28-33 are on appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Applicants acknowledge the Examiner's withdrawal of the rejection of claim 2 under 35 U.S.C. §112, first paragraph, and the rejection of claims 1, 2, 4, 7, 8, 28-30 and 33 as unpatentable under 35 U.S.C. § 102(e). The only remaining grounds of rejection to be reviewed on appeal is whether claims 1, 2, 4, 7, 8 and 28-33 are unpatentable under 35 U.S.C § 103(a) as unpatentable over Wolinsky in view of U.S. Patent No. 5,749,920 ("Quiachon").

III. ARGUMENT

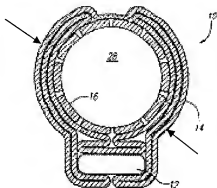
Rejection Under 35 U.S.C. §103(a) Over U.S. Patent No. 6,840,956 in View of U.S. Patent No. 5,749,920

The Examiner's Answer indicates on page 6 that "Wolinsky's graft having Quiachon's marker placement, inherently folds over the markers as well as the sensor since Wolinsky's graft is folded and overlapped several times, leaving less than 50%, more likely only 1/3, of the graft exposed (non-covered), see figs. 3a, 3b and col.5, lines 38-48; and since Quiachon's markers are placed diametrically 180 degrees apart from one another, at least one line of markers inherently must be covered and protected (since they are 50% the distance of the graft circumference away from each other; and less than 50% of Wolinsky's graft is exposed.)"

In reaching such a position, the Examiner makes an unsupported assumption that is contrary to the teaching of the references. As the Federal Circuit has recognized, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. §2141.03 citing W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983) cert. denied 469 U.S. 851 (1984).

As explained in the Appeal Brief, Quiachon teaches away from the markers being positioned along an area that may be folded or otherwise folded over. Quiachon explains at column 14, lines 46-53, that "[b]y placing markers of different lengths along the axis of the tubular member, it is possible to ascertain the position of the graft 55 and to determine whether the graft has twisted between its superior and inferior ends 171, 172. Under fluoroscopy, the two sets markers will be exhibited as two relatively straight lines for an untwisted graft, wherein a twisted graft will be revealed by a non-linear pattern of markers." (emphasis added). To position the markers at a position where they may be folded over or folded upon, may twist the markers and prevent the markers from being used to determine whether the graft has twisted. Quiachon teaches against the combination proposed in the Office Action.

Contrary to the combination as proposed by the Examiner, one skilled in the art when presented with the teachings of Wolinsky and Quiachon would more likely position the markers outside the folded areas, as indicated in the figure below, to insure the markers are opposed and not covered.




The Office Action and the Examiner's Answer fail to provide any reasonable basis for placing markers on the device of Wolinsky such that they are covered by folded portions of the graft. To the contrary, Wolinsky and Quiachon, even if combined, do not disclose every limitation of the claimed invention, but instead teach away from the claimed invention. The proposed combination is based only on impermissible hindsight and unsupported assumptions.

It is respectfully submitted that a *prima facie* case of obviousness has not been established. Appellants respectfully request reconsideration and reversal of the rejection of claims 1, 2, 4, 7, 8 and 28-33 under 35 U.S.C. §103(a).

Accordingly, for at least the reasons set forth above and in appellants August 21, 2007 Appeal Brief, appellants respectfully contend that independent claim 1 and dependent claims 2, 4, 7, 8 and 28-33 of this application are now in condition for allowance. Appellants respectfully request reversal of the Final Rejection.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "JL Massina", is written over a horizontal line.

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Dated: November 26, 2007

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